

REMARKS

Claims 1-54 are pending in this application. Claims 1 and 19-22 are independent claims. Claims 1, 2, 4-10, 13, 16, and 19-22 are amended. Claims 3, 11, 12, 14, 15, 17 and 18 are canceled. Claims 23 – 54 are new. Reconsideration and allowance of the present application are respectfully requested.

Provisional Double Patenting Rejections

Claims 1-22 stand provisionally rejected on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/759,425. Applicants acknowledge this provisional rejection, and will take the appropriate steps to address this rejection once the claims in the present application and the claims in pending application No. 10/759,425 are indicated as including allowable subject matter since this provisional rejection is based on claims that may change. Further, Applicants respectfully request the Examiner reconsider this rejection in view of the amended claims. Moreover, Applicants respectfully submit claims 1-22 of the current application and claims 1-18 of copending Application No. 10/759,425 are patentably distinct, as detailed below.

Applicants submit that to establish a *prima facie* case of nonstatutory-type double patenting rejection, the Examiner must first identify the inventions claimed in the claims under consideration and in the reference patent claims. The Examiner must then establish that any variation between the inventions claimed in the claims under consideration and the earlier-issued patent claims would have been obvious to a person having ordinary skill in the art.

Based on U.S. case law, the Examiner's showing of obviousness must follow the analysis used to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a); the burden of proof would then shift to the applicant to rebut the *prima facie* case. See *In re Longi*, 225 USPQ 645, 651 (Fed. Cir. 1985).

On page 3 of the Office Action, Examiner states that “although the conflicting claims are not identical, they are not patentably distinct from each other.” More specifically, Examiner states that “both inventions relate to managing reproduction of still images and related data associated with the still pictures with the related data being graphic data and subtitle data.” Further, Examiner states that “both inventions also relate to multiplexing the still image and the related associated data into transport stream and packetized elementary streams.” However, as

an example, Applicants submit that claim 1 of the current application appears to be patentably distinct from claim 1 of the copending application. In particular, independent claim 1 of the copending Application No. 10/759,425 recites *inter alia* “reproducing **audio data from a second file**” while independent claim 1 of current application No. 10/759,460 recites *inter alia* “the related data **not including audio data**.” Therefore, it is not possible to read on both claims simultaneously. The audio data, or lack thereof, determines which claim is read upon. Therefore, at the very least, at least some of claims 1-22 of the current application and at least some of claims 1-18 of copending Application No. 10/759,460 are patentably distinct from each other. Should Examiner still find certain claims to be patentably indistinct between the two copending applications, Applicants respectfully submit that Examiner specify and explain, with respect to the obviousness standards described above, those claims of the copending applications that Examiner alleges to be patentably indistinct.

Claim Rejections
Rejections under 35 U.S.C. §101

Claims 1-18 stand rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. This rejection is respectfully traversed.

Applicants respectfully submit that the Examiner has incorrectly characterized the recording medium as storing **nonfunctional** descriptive material. The Manual of Patent Examining Procedure (MPEP) provides guidance on the difference between “nonfunctional descriptive material” and “functional descriptive material”. In particular, MPEP § 2106.01 states the following.

In this context, “functional descriptive material” consists of **data structures** and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited music, literary works and a compilation or mere arrangement of data. (emphasis added).

Accordingly, Applicants respectfully submit that “a computer-readable medium having a data structure for managing reproduction of still images” as recited in independent claim 1 is a recording medium storing **functional** descriptive material.

MPEP §2106.01(I) further states, regarding functional descriptive material, that “a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.” The computer readable medium recited in claim 1 includes a data structure comprising a data area and a navigation area which provides navigation information. Claim 1 recites “a navigation area storing at least one playlist, the playlist including at least one playitem and at least one sub-playitem, the playitem providing navigation information for reproducing the presentation data from the first clip file, the sub-playitem providing navigation information for reproducing the audio data from the second clip file.” Accordingly, because the computer readable medium recited in claim 1 includes a navigation area for managing reproduction of still images, claim 1 is clearly directed towards patentable, statutory subject matter.

In light of the above, Applicants respectfully request that the 35 U.S.C. §101 rejections of claims 1 and all claims which depend thereon be withdrawn.

For similar reasons, Applicants respectfully request that the 35 U.S.C. §101 rejection of claim 17 be withdrawn.

**Rejections under 35 U.S.C. §102 – Okada et al./ 35 U.S.C. §103 –
Okada et al. and Hamada et al.**

Claim 17 stands rejected under 35 U.S.C. §102(b) as being anticipated Okada et al. (U.S. Patent No. 6,122,436). Claim 18 stands rejected under 35 U.S.C. §103(a) as being obvious over Okada et al. (U.S. Patent No. 6,122,436, hereinafter “Okada”) in view of Hamada et al. (U.S. Patent Number 6,999,674, hereinafter “Hamada”). Claim 17 has been amended to incorporate the limitations of claim 18. Applicant respectfully traverses this rejection.

The applicant submits that Claim 17, as amended, is not anticipated by Okada. According to MPEP 2131 “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” Okada does not describe “a navigation area storing at least one playlist...” as claimed in claim 17. Since the “navigation area storing at least one playlist...” is not described in Okada, Okada does not anticipate claim 17.

For the above reason, the Applicants respectfully request that the 35 U.S.C. §102(b) rejection of claim 17 based on Okada be withdrawn.

The applicant submits that Claim 17 is not rendered obvious by Okada in further view of Hamada. “To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” MPEP 2143.03.

The Examiner relies on Hamada to disclose “a navigation area storing at least one playlist, the playlist including at least one playitem and at least one sub-playitem (clip)” and cites Figure 2, column 6 lines 17-18 and 35-36 for support. The Examiner also alleges that Hamada discloses “the playitem providing navigation information for reproducing the presentation data from the first clip file, the sub-playitem providing navigation information for reproducing the audio data from the second clip file” and cites column 6, lines 11-18 of Hamada. Contrary to the Examiner’s assertion, Hamada does not disclose a “**sub-playitem**” nor does Hamada teach that a sub-playitem provides “navigation information for reproducing the **audio data** from the **second clip file**” as recited in amended claim 17.

Hamada teaches the use of a playlist, but Hamada’s playlist contains only playitems. As described in Hamada in column 6, lines 11-19

The Playlist is composed of information which designates an AV stream and information representative of a reproduction start point (IN point) and a reproduction end point (OUT point) in the AV stream. **A set of information which designates an AV stream and information representative of a start point and an end point of the AV stream is collectively referred to as Playitem.** In other words, a Playlist is composed of one or more Playitems.

This is different from that being claimed in claim 17. Claim 17 claims both “play items” which provides “navigation information for reproducing the presentation data from the first clip file” and a “**sub-playitem**” which provides “**navigation information for reproducing the audio data from the second clip file.**” Since the limitation and use of a sub-playitem as claimed in claim 17 is not taught or suggested in the cited prior art then claim 17 is not rendered obvious.

For the reasons stated above the Applicant requests that the 35 U.S.C. §103(a) rejection of claim 17 based on Okada in view of Hamada be withdrawn.

For similar reasons the Applicant requests that the 35 U.S.C. §103(a) rejection of claim 15 be withdrawn as well.

Rejections Under 35 U.S.C. § 103 – Okada et al. in view of Sako et al.

Claims 1-3, 11-14, 16, 19 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,122,436 (“Okada et al.”) in view of U.S. Patent No. 6,829,211 (“Sako et al.”). This rejection is respectfully traversed.

The Applicants submit that the Examiner has not made a prima facie case of obviousness for claim 1 based on Okada in view of Sako for at least two reasons: 1) the combination of Okada and Sako do not disclose a navigation area storing at least one playlist; and 2) the combination of Okada and Sako do not teach managing the non-audio data as “still picture units, each still picture unit including at least one still picture and associated related data, the related data not including audio data.”

As amended, claim 1 recites “a navigation area storing at least one playlist, the playlist including at least one playitem and at least one sub-playitem, the playitem providing navigation information for reproducing the presentation data from the first clip file, the sub-playitem providing navigation information for reproducing the audio data from the second clip file.” This feature is not disclosed in either Sako or Okada. Since neither Sako nor Okada disclose this feature of claim 1 then Okada in view of Sako does not render claim 1 obvious to one skilled in the art.

Furthermore, Sako proposes a data record medium with several record areas, some areas compatible with the CD standard, other areas that are not (See column 1, lines 19-29). An example embodiment provided by Sako describes a medium where one area has audio information recorded compatible with the CD format and a second area where the data is compressed and encrypted and is not compatible with the CD format (see column 1, lines 22-25). In order to more fully explain his record medium, Sako describes his record medium in conjunction with audio data. The Examiner, however, cites column 16, lines 66-67, and column 17, lines 1-3 to show that while Sako’s embodiments were explained in terms of audio information that his same proposed data record medium could be “applied to contents of video data, still picture data, character data, computer graphic data, game software and computer programs other than audio.” Sako, however, does not disclose or suggest managing the non-audio data as “still picture units, each still picture unit including at least one still picture and associated related data, the related data not including audio data” as claimed in claim 1.

Okada teaches a recording medium that has recorded thereon a video part stream comprising a plurality of units containing still picture data for at least one picture and an audio part stream, such as a second system stream, comprising one or a plurality of units containing audio data to be reproduced with the still picture data (see Okada, column 2, lines 15-23). However, Okada does not teach “presentation data being divided into a number of still picture units, each still picture unit including at least one still picture and associated related data, the related data not including audio data.” As claimed in claim 1.

Neither Sako nor Okada teach or suggest “a data area storing presentation data, the presentation data being divided into a number of still picture units, each still picture unit including at least one still picture and associated related data, the related data not including audio data,” as recited in claim 1, therefore, even if one were to combine the teachings of Okada and Sako, one skilled in the art would not have arrived at the limitation as claimed in claim 1. Therefore, claim 1 is not obvious.

For the reasons stated above the Applicant requests that the rejection of claim 1 and all claims which depend thereon be withdrawn.

For similar reasons the Applicant requests that the rejection of claims 19 and 20 be withdrawn.

**Rejections Under 35 U.S.C. § 103 – Okada et al. in view of
Sako et al. in further view of Hamada et al.**

Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,122,436 (“Okada et al.”) in view of U.S. Patent No. 6,829,211 (“Sako et al.”) in further view of U.S. Patent No. 6,999,674 (“Hamada et al.”). This rejection is respectfully traversed.

Even if one were to combine Sako and Okada as suggested by the Examiner and were to arrive at the features recited in claim 1, which the Applicants do not admit, one would still not have arrived at a recording medium “wherein the presentation data is multiplexed into a transport stream” as recited in claim 4.

The Examiner rejects claim 4 arguing that while a combination of Okada and Sako does not teach a recording medium wherein the presentation data is multiplexed into a transport stream, Hamada teaches a recording medium wherein the presentation data is multiplexed into a transport stream (column 6, lines 23-24). The Examiner alleges it would have been obvious to

one of ordinary skill in the art at the time of the invention to incorporate multiplexing of still image data into transport streams as taught by Hamada into the recording medium of Okada and Sako in order to be able to transport the data in sync with related data. The Applicant respectfully disagrees.

Hamada teaches “[a]n AV stream is a bit stream multiplexed in the form of a transport stream or the like prescribed by the MPEG...” (column 6, lines 23-24). Hamada does not teach multiplexing only the picture data and the associated related data, the related data not including audio data. Therefore, since this limitation is not taught by Okada and Sato (as admitted by the examiner) and was not taught by Hamada, then it would not be obvious to arrive at this limitation even if one were to combine Okada, Sako, and Hamada. Because the limitations of claim 4 are not obvious the Applicant respectfully requests the 35 U.S.C. § 103(a) rejection of claim 4 and all claims which depend thereon be withdrawn.

Another reason for traversing Examiner’s 35 U.S.C. §103(a) rejection is that there is no motivation to combine Hamada with Sato or Okada. Okada teaches

When image data and audio are recorded using the MPEG standard, the audio stream and video stream are multiplexed and recorded as a single system stream as shown in FIG. 6(c). This makes it very difficult to freely change the audio stream associated with a particular video stream after the initial recording. More specifically, to change the audio data recorded for a particular still picture, the still picture data and audio data must be edited together as a single MPEG system stream. This means that the MPEG system stream must first be decoded, and the extracted still picture data and audio data must then be re-encoded as a single system stream after editing. Editing the still picture data and audio data after recording is therefore much more difficult than it is with a conventional digital camera. Okada, column 1, lines 60-67 and column 2, lines 1-6.

Similar problems associated a multiplexed AV stream are echoed in Hamada (column 1, lines 26-45). Hamada’s solution to editing the single multiplexed AV stream was to create a playlist file to perform nondestructive editing. Okada’s solution, however, was to avoid generating a single multiplexed AV file and instead to generate two separate system streams, one for the audio and one for the video. One skilled in the art would not have combined Hamada with Okada since Okada teaches away from such a combination. Furthermore, as stated in MPEP 2145(X)(D)(2) “it is improper to combine references where the references teach away from their combination.” Therefore, Applicant respectfully requests that the Examiner withdraw

the 35 U.S.C. § 103(a) rejection of claim 4 and all claims which depend thereon based on the improper combination of references.

In light of the above arguments the applicant respectfully requests that the 35 U.S.C. §103(a) rejection of claim 4 and all dependent claims which depend thereon be withdrawn.

Rejections Under 35 U.S.C. § 103 – *Hamada et al in view of Sako*

Claims 21 and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,999,674 (“Hamada et al.”) in view of U.S. Patent No. 6,829,211 (“Sako et al.”). This rejection is respectfully traversed.

As stated above, the Applicants submit that Sako does not teach “managing the non-audio data as “still picture units, each still picture unit including at least one still picture and associated related data, the related data not including audio data” as recited in claim 1. As admitted by the Examiner on page 10 of the office action, Hamada “does not disclose still picture units and associated related data.” Since neither Hamada nor Sako teach “still picture units, each still picture unit including at least one still picture and associated related data, the related data not including audio data” as recited in claim 1, claim 1 is not rendered obvious by the combination of Hamada in view of Sako to one skilled in the art.

For this reason the Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claim 21 be withdrawn.

For similar reasons the Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claim 22 be withdrawn as well.

New Claims 23 – 54

Applicants request new claims 23-54 be considered and allowed.

CONCLUSION

In view of the above remarks and amendments, Applicants respectfully submit that each of the rejection has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.


Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) hereby petition(s) for a one (1) month extension of time for filing a reply to the outstanding Office Action and submit the required \$120.00 extension fee herewith.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Gary D. Yacura at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKY, & PIERCE, P.L.C.

By:  55,149
FOR Gary D. Yacura, Reg. No. 35,416
P.O. Box 8910
Reston, Virginia 20195
(703) 668-8000

GDY/DMB/lo